

REMARKS

Claims 1, 6-8, 10-12, and 49-60 are currently pending in the application. In view of the following remarks, Applicant maintains all of the claims are in condition for allowance, and requests reconsideration of the claims currently pending in the application.

Applicant notes that the Information Disclosure Statements filed on September 27, 2002 and January 31, 2003 have not been acknowledged by the Examiner, and respectfully requests the Examiner to acknowledge the Information Disclosure Statements in the next Office communication.

On page 2 of the Office Action, claims 1, 6-8, 10-12, and 49-60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jansen (U.S. Patent No. 6,528,006) in view of Yamane, et al. (U.S. Patent No. 5,875,004). Applicant respectfully traverses these rejections.

In the interest of brevity, Applicant incorporates by reference its arguments made in the communication filed 11/24/03. Applicant acknowledges that the Examiner has agreed Jansen teaches melting and burning rather than imaging. The Examiner, however, contends the Office Action relies on Yamane, et al. to teach the claimed imaging technique. The Examiner further contends an applicant cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references, citing *In re Keller*, 642 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant maintains the combination of reference fails to meet the claimed invention.

The Examiner also has agreed that Yamane, et al. deals with quality inspection. The Examiner contends he does not rely on Yamane et al. to teach control of the laser, as Jansen already teaches controlling a laser (col. 4, ll. 40-50), and that he relies on Yamane, et al. to teach the claimed imaging technique as Yamane et al. deals with judging quality of products in manufacturing processes (see col. 1, ll 5-10).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner cites *In re Fine* and *In re Jones*, and contends he recognizes obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Yet the Examiner has cited no such teaching, suggestion or motivation in the references or the knowledge generally available to one of ordinary skill in the art. Applicant respectfully objects to what is presumed to be Official Notice, and requests the Examiner cite references in support of this position.

The Examiner contends it would have been obvious in the instant case to one of ordinary skill in the art at the time of the invention to modify the method of Jansen in order to utilize a process control method in order to automatically execute a visual inspection (Yamane, et al., col. 1, ll. 10-20). The Examiner has not considered the claimed invention as a whole. In determining the differences between the prior art and the claims, the question under section 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.* 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983), *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983),

Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543 551 (Fed. Cir. 1985); MPEP 2141.02.

The Examiner contends it must be recognized that any judgment on obviousness is necessarily a reconstruction based on hindsight reasoning, but so long as it does not include knowledge gleaned only from Applicant's disclosure, such a reconstruction is proper. Applicant maintains improper hindsight reconstruction in view of Applicant's disclosure has been employed.

Applicant maintains that the Office Action fails to make out a *prima facie* case of obviousness. The Examiner has the burden of establishing a *prima facie* case of obviousness, and in order to do so, the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Citing *In re Keller*, the court in *In re Fine* stated that, "obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981). It "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The MPEP also states that three criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Applicant respectfully maintains the Office Action does not make out a *prima facie* case of obviousness. The cited art fails to disclose all the claim limitations and there would be no motivation to combine the references as proposed by the Examiner.

The references do not recognize the problem that Applicant's claimed invention solves. Applicant's claimed invention set forth in independent claim 1 solves the problem of producing a prosthesis by a method including at least partially cutting a material segment with a beam, wherein the cutting is controlled by a process unit to cut the material to correspond with a target image. It is acknowledged that Jansen teaches ablation with a laser. Yamane et al. pertain to an image processing inspection apparatus for judging the quality of products in manufacturing processes. Neither Jansen nor Yamane, et al., either singly or in combination, disclose, teach or suggest control by a process unit to cut material to correspond to a target image. The combination fails to meet all of the limitations of independent claim 1 and the claims depending therefrom.

The combination also fails to meet the limitations of claims 49, 52, 53 and 57, and claims depending therefrom. Claims 49, 52, 53, and 57 set forth methods which include imaging performed with a laser and detector (claim 49), cutting controlled by a process control unit (claim 52), cutting a tissue sheet to separate portions thereof with a thickness

outside a selected range of thickness provided by a target image (claim 53), and imaging of the tissue sheet which produces a digital image (claim 57). Neither Jansen nor Yamane et al., either singly or in combination, disclose, teach or suggest these limitations.

There must be a teaching which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses, and the Examiner has failed to cite such a teaching. The Office Action fails to provide a specific reason why it would have been obvious to combine the references. The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir 1990); MPEP 2143.01. The Examiner must provide a specific reason to support an obviousness rejection. *Ex Parte Humphreys*, 24 USPQ2d 1255 (BPAI 1992). The Examiner's remarks appear to be an acknowledgement that hindsight reconstruction has occurred in view of Applicant's disclosure. There is clearly no support or motivation for the cited combination other than Applicant's disclosure. Withdrawal of the stated rejection is respectfully requested.

Dependent claims 6-7, 50-51, which are dependent from independent claim 1, claims 8 and 10-12 which depend from claim 7 (also depending from claim 1), were also rejected under 35 U.S.C. §103(a) as being unpatentable over Jansen and Yamane, et al. In addition to dependent claims 49, 52, 53, and 57 which depend from claim 46, claims 54-56 and 58-59 (depending from claim 53), and claim 60 (depending from claim 57), were also rejected under 35 U.S.C. §103(a) as being unpatentable over

Jansen and Yamane, et al. While Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are moot in view of the remarks made in connection with independent claim 1 and claims 49, 52-53 and 57. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, all of the pending claims are in condition for allowance.

Applicant respectfully requests withdrawal of the rejection of claims 1, 6-8, 10-12, and 49-60 under 35 U.S.C. § 103(a) as being anticipated over Jansen in view of Yamane, et al.

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. Applicant respectfully requests favorable reconsideration and early allowance of all pending claims.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Hallie A. Finucane at (952) 253-4134.

Respectfully submitted,

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Date: July 27, 2004

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